

**REMARKS****A. INTRODUCTION**

Claims 1-72 and 74-126 are pending and rejected.

Claim 73 was previously cancelled.

Claim 33 is objected to.

The drawings are objected to.

Upon entry of this Amendment:

- Claims 1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126 will be pending
- Claims 1, 2, 9, 11, 13, 16, 17, 19, 22, 28, 30, 33, 35, 47, 48, 74, AND 108 will be amended
- Claims 8-11, 44-46, 60, 73, 80, 81, and 105-107 will be cancelled
- FIG. 1A will be amended
- Claims 1, 2, 9, 13, 17, 19, 22, 28, 30, 33, 35, 47, 48, 74, 108, 119, and 123-126 are independent

**B. REQUEST FOR CONTINUED EXAMINATION**

This paper is being filed in response to an Office Action mailed February 3, 2006. A Request for Continued Examination (RCE), along with the appropriate fee, is being filed concurrently to ensure consideration of these remarks.

**C. REQUEST FOR PRIORITY INFORMATION**

With respect to the Examiner's request for priority information based on the claim of priority to U.S. Patent Application No. 09/012163, Applicants have with this Amendment removed the claim of priority to that application.

The Examiner requested that Applicants identify which inventor(s) contributed which specific features claimed in the present application. Upon consultations with and review of claimed subject matter by Magdalena Fincham and Jay Walker (the only named inventors currently employed by Walker Digital, LLC or its affiliate Walker Digital Management, LLC), each indicated that they contributed subject matter to all of the independent claims now pending. Information about specific features is not known.

**D. INDEPENDENT CLAIM 33**

Claim 33 has been objected to as being an improper independent claim. Claim 33 has been amended to recite literally the subject matter that was previously incorporated by reference to Claim 32.

**E. AMENDMENT TO DRAWINGS / AMENDMENT TO SPECIFICATION**

FIG. 1A has been amended to indicate that a customer device (including customer service devices) may comprise (optionally) a bar code reader. The Specification has been amended correspondingly to refer to the bar code reader. No new matter has been added. See, e.g., page 8, line 15 to page 9, line 6; page 12, lines 11-23.

**F. SECTION 112 ¶ 1 REJECTION: LACK OF WRITTEN DESCRIPTION/ENABLEMENT**

Claims 1-72 and 74-126 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. We respectfully traverse the Examiner's Section 112 ¶ 1 rejection of Claims 1-72 and 74-126.

Specifically, the Examiner states: "The claims appear to require an inquiry into the customer's state of mind." [Office Action, page 8]. The Examiner, however, has not explained why any particular claim is not enabled.

With respect to Claims 1, 47, 74, 83, 119-124, and 125-126, Applicants have used reasonably particular language to describe features by which a customer's interest may be indicated, detected, or interpreted. Various examples of how interest in a product may be determined, interpreted, detected, relied upon, or indicated, based on various types of available information (there is no need to read customers' minds) are provided in the disclosure. For instance, a customer may express an interest in a particular product by engaging in particular activities associated with that product. See, e.g., page 15, lines 3-16; page 20, line 25 to page 21, line 13.

With respect to Claims 36-38, 58, 59, 64, 65, 97-99, 40, and 101, the Examiner asserts that the disclosure does not describe how a customer service device performs the claimed functions. Applicants respectfully disagree. A customer service device is a one type of customer device. See, e.g., page 13, lines 11-23. Various types and potential components (e.g., bar code readers, printers, portable input devices, displays) of customer devices (and therefore customer service devices) suitable for performing the claimed functions are disclosed. See, e.g., page 8, line 15 to page 9, line 6; page 11, line 16 to page 13, line 2; page 13,

lines 11-23; page 28, lines 19-22; page 30, lines 1-6. The claimed subject matter is disclosed, and one of ordinary skill in the art would have readily understood in light of the disclosure how to make or use the claimed subject matter without undue experimentation.

With respect to Claims 41, 58, 67 and 102, the Examiner asserts that certain functions of a point of sale terminal are not described. Applicants respectfully disagree. First, Applicants believe that the subject matter with which the Examiner takes issue in each of Claims 41, 58, 67 and 102 appeared in those claims as originally filed, and therefore what they disclose is part of the Specification. The Examiner has not rebutted the strong presumption that Applicants were in possession of the originally claimed subject matter. Further, various examples of point-of-sale terminals, and the functions they may provide are described in the Specification. See, e.g., page 13, lines 3-10; page 22, line 19 to page 20, line 10; page 29, line 30 to page 30, line 30. One of ordinary skill in the art would have readily understood in light of the disclosure how to make or use the claimed subject matter without undue experimentation.

For at least the above reasons, Applicants respectfully request reconsideration of the Section 112, para. 1 rejections of the pending claims.

#### **G. SECTION 102(E) & SECTION 103(A) REJECTIONS**

Claims 1-2, 4-11, 14-15, 18-19, 21-22, 25-31, 47-49, 51-54, 57, 68, 72, 74, 76-81, 83, 87, 90-94, 108, and 111-113 stand rejected under 35 U.S.C. 102(e) as being anticipated by Blinn (U.S. Patent No. 5,897,622). We respectfully traverse the Examiner's Section 102(e) rejection.

Claims 3, 12-13, 16-17, 20, 23-24, 32-33, 36-43, 50, 58-67, 75, 82, 84-86, 88-89, 95-104, 109, 110, and 115-117 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Blinn.

Claims 16, 17, 34 and 35 stand rejected as being unpatentable over Blinn and in further view of Gupta (U.S. Patent No. 6,820,062).

Claims 44-46, 54-56, 69-72, 105-107, 114 and 118 are rejected as being unpatentable over Blinn and further in view of Alba (Interactive home shopping: Consumer, retailer, and manufacturer incentives to participate in electronic marketplaces, July 1997, Bolv. 61, Iss 3; pg. 38).

#### **1.01. Claims 8-11, 44-46, 60, 80, 81, and 105-107 are cancelled**

The rejection of cancelled Claims 8-11, 44-46, 60, 73, 80, 81, and 105-107 is moot.

**1.02. Independent Claims 1, 2, 19, 22, 28, 30, 47, 48, 74, and 108**

Each of the independent claims 1, 2, 19, 22, 28, 30, 47, 48, 74, and 108 now generally recites the following claim feature, which is not taught or suggested by Blinn:

*wherein at least one of the at least one secondary product is a product not currently selected for purchase by the customer, and further wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of interest, by the customer, in the at least one secondary product and further wherein the at least one secondary product does not have a pre-established relationship with the primary product*

Blinn does not teach or suggest the above feature. Rather, Blinn is limited to offering to a customer a cross-sell product that is associated in a database with the product selected for purchase by the customer. See, for example, column 21, line 62 through column 22, line 45 and Fig. 13B. There is no description or hint in Blinn of selecting a cross-sell product based on an indication of interest in the cross-sell product by the customer. The Examiner's assessment of customer registration is not supported by Blinn. Only cross-sell products that a merchant had previously associated in a database with the product selected for purchase by the customer are offered to the customer in Blinn, irrespective of whether the customer had indicated any interest in the cross-sell product in the database. Further, since Blinn is strictly database-driven and there is no description or enablement in Blinn of tracking a customer's interest in a for any purpose, much less for the purpose of later including the product in a package being offered to the customer, it would not be obvious to modify Blinn to include such a feature.

In contrast, various embodiments of the present invention allow for greater flexibility in considering secondary products that do not already have a pre-established relationship with the primary product, such as secondary products about which the system may have information that the secondary products are already of interest to the customer (e.g., based on information about prior transactions).

Accordingly, Applicants respectfully request reconsideration of the rejections of all of the independent claims 1, 2, 19, 22, 28, 30, 47, 48, 74, and 108 (their associated dependent claims).

**2. Claims 16 and 17**

In addition to the amendment described above with respect to independent Claims 1 and 17, Claims 16 and 17 have been further amended to recite wherein

*the previous transaction including at least one previously sold product that does not include the primary product.* Neither Blinn nor Gupta, alone or in combination, teaches or suggests such a feature. Accordingly, determining the at least one secondary product does not involve information about the customer's purchase history of the primary product.

### **3. Claims 119-126**

Claims 119-126 stand rejected as being unpatentable over Blinn and further in view of Bernard (U.S. Patent No. 5,918,213).

#### **3.01. Independent Claims 119, 123, 124, 125 and 126**

The rejection of Claims 119, 123, 124, 125 and 126 is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has failed to provide substantial evidence that the following features were known at the time of invention:
  - (i) *in response to detecting the loss of interest in the primary product,*
  - (ii) *determining a package to be offered to the customer,*
  - (iii) *the package comprising the primary product and at least one secondary product,*
  - (iv) *the primary product and the at least one secondary product each having a corresponding retail price; and*
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

The Examiner admits that “Blinn does not specifically disclose detecting a loss of interest in the primary product and that determining a package to be offered to a customer occurs in response to detecting the loss of interest in the primary product.” [Office Action, page 44].

The Examiner asserts that “Bernard discloses tracking events such as when a customer removes items from a shopping, thereby detecting a loss of interest in a primary product by customers. See, for example, Col. 33, lines 4-63.” [Office Action, page 44].

The cited portion of Bernard states: “VRU 104 may prompt the caller to either put the selections which are on hold back into the virtual shopping cart or to delete the selection from the list of items on hold.” Column 33, lines 13-16.

Bernard thus possibly might have suggested, to one of ordinary skill in the art, identifying a selection that is “on hold,” and somehow prompting caller to either place the selection back into a virtual shopping cart or to delete the selection.

Contrary to the Examiner's assertion, however, nothing in the cited portion or otherwise in Bernard teaches or suggests "tracking" events such as a customer removing an item from a shopping cart. At best, there is a suggestion of a list of items "on hold." There is no suggestion that deletion of an item "on hold" is a "tracked" event, whatever that means to the Examiner.

Further, Bernard does not suggest *determining a package to be offered to the customer in response to detecting the loss of interest in the primary product*. There is no suggestion of doing anything in response to having items "on hold" other than the explicitly described prompt to the caller, much less determining a package of any kind to offer a customer.

As described in the very portion of Bernard cited by the Examiner, a caller is given a choice only between deleting an item from an "on hold" list or putting it back in a shopping cart. Nothing in Bernard suggests doing anything else with an item a caller wants "discarded"—except deleting it from the "on hold" list, of course.

Effectively, the Examiner has inappropriately attempted to demonstrate that individual elements of the limitation are present in Bernard and fails to address the limitation in its entirety.

Applicants have repeatedly read both Blinn and Bernard, and have found no hint that either reference teaches any limitation present in Claims 119, 123, 124, 125, and 126.

To the extent that the Examiner is relying solely upon Blinn and Bernard as teaching all the features recited in Claims 119, 123, 124, 125, and 126, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of all such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness, and Blinn nor Bernard cannot support any such rejection. The rejection fails for at least this reason.

As a motivation for the providing the specific feature, the Examiner states that one would have been motivated to combine Blinn and Bernard

for the obvious reason that merchants often wish to provide maximum flexibility to a customer by permitting a customer to review the items in a shopping basket and may offer package or discounts on removed items to prevent customers from walking out and possibly buying the same primary item at a competitor.

[Office Action, page 45].

No evidence, much less substantial evidence, is offered in support of this asserted “obvious” motivation. Neither Bernard nor Blinn suggests the hypothetical “offer a customer a package comprising the “discarded” primary item and an additional item” or the hypothetical “obvious reason” proposed by the Examiner. As described in the very portion of Bernard cited by the Examiner, a caller is given a choice only between deleting an item “on hold” or putting it back in a shopping cart. Nothing in Bernard suggests doing anything else with an item a caller wants “discarded”—except deleting it, of course.

The Examiner thus essentially argues that Applicants’ invention is a good and beneficial idea, and does not even attempt to find any evidentiary basis for the purported motivation or other apparent reason to provide specifically for the claimed features. The asserted motivation is not a finding of a teaching of the prior art that would have motivated one of ordinary skill in the art to make the suggestion combination. The Examiner appears to have derived the motivation from reading the Applicants’ disclosure, which is impermissible.

The Examiner has not provided any evidence of record or shown that the references contain any motivation to one of ordinary skill in the art to combine the references in the manner suggested by the Examiner to provide specifically for the feature of *in response to detecting the loss of interest in the primary product, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price.*

Further, the Examiner simply has not even asserted any motivation supported by the cited references or by substantial evidence of record to modify or combine the references to provide for the specific recited features.

Thus the Examiner has not shown substantial evidence of record of an apparent reason to combine or modify the references in any manner that renders any of Claims 119, 123, 124, 125 and 126 obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness.

Even if the Examiner had established substantial evidence of a motivation to make the proposed combination of Blinn and Bernard (which Applicants dispute above), the Examiner has failed to provide substantial evidence of a motivation to modify that combination to provide for the feature *in response to detecting the loss of interest in the primary product, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price.*

In fact, even if the references were combined in the manner suggested (let alone any other manner that the Examiner failed to suggest), the proposed combination would fail to teach *in response to detecting the loss of interest in the primary product, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price.*

Nothing in any reference of record even hints at, in response to detecting the loss of interest in the primary product, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price. In fact, the Examiner has failed to show that any reference of record determines a package in response to determining the loss of interest in the primary product. As such, any combination of the references of record fails to teach this limitation. The Examiner does not assert otherwise.

For any one of the above reasons, Applicants request the reconsideration of the rejection of Claims 119, 123, 124, 125 and 126.

### **3.02. Claim 120**

Claim **120** depends from Claim 119 and includes the following addotopma; limitation:

- detecting a loss of interest in the primary product comprises:
- detecting that the customer has removed the primary product from a virtual shopping basket associated with the customer

As discussed above with respect to Claims 119, 123, 124, 125 and 126, the Examiner has failed to establish substantial evidence of doing anything in response to detecting a loss of interest, much less determining a package to offer. Bernard does not suggest *determining a package to be offered to the customer in response to detecting the loss of interest in the primary product*. There is no suggestion of doing anything in response to having items “on hold” other than the explicitly described prompt to the caller, much less determining a package of any kind to offer a customer.

Similarly, the portion of Bernard relied upon by the Examiner (Col. 5, line 58-Col. 6, line 10) cannot support the Examiner’s assertion that it was known to determine a package offer in response to *detecting that the customer has removed the primary product from a virtual shopping basket associated with the customer*.

In Bernard, a caller is given a choice only between deleting an item or putting it back in a shopping cart. Nothing in Bernard suggests doing anything else



with an item a caller wants “discarded” or removed from a list of “on hold” items—except deleting it, of course.

Nothing in Bernard teaches or suggests “tracking” events such as a customer removing an item from a shopping cart, let alone *detecting that the customer has removed the primary product from a virtual shopping basket associated with the customer*, much less doing anything in response to detecting such an event.

Effectively, the Examiner has inappropriately attempted to demonstrate that individual elements of the limitation are present in Bernard and fails to address the limitation in its entirety.

Applicants have repeatedly read both Blinn and Bernard, and have found no hint that either reference teaches any limitation present in Claim 120.

To the extent that the Examiner is relying solely upon Blinn or Bernard as teaching any feature recited in Claim 120, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness, and Blinn nor Bernard cannot support any such rejection. The rejection fails for at least this reason.

Further, the Examiner simply has not even asserted any motivation supported by the cited references or by substantial evidence of record to modify or combine the references to provide for the specific recited features of Claim 120.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Claim 120 obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Claim 120 fails for at least this reason.

Even if the Examiner had established substantial evidence of a motivation to make the proposed combination of Blinn and Bernard (which Applicants dispute above), the Examiner has failed to provide substantial evidence of a motivation to modify that combination to provide for the feature *detecting that the customer has removed the primary product from a virtual shopping basket associated with the customer*.

In fact, even if the references were combined in the manner suggested (let alone any other manner that the Examiner failed to suggest), the proposed combination would fail to teach *detecting that the customer has removed the primary product from a virtual shopping basket associated with the customer*.

Nothing in any reference of record even hints at, *detecting that the customer has removed the primary product from a virtual shopping basket associated with the customer*. As such, any combination of the references of record fails to teach this limitation. The Examiner does not assert otherwise.

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and Claim 120 is patentable.

### 3.03. Claim 121

Claim 121 contains the following limitation:

wherein detecting a loss of interest in the primary product comprises:

determining that the customer has expressed interest in another product without having placed the primary product in a virtual shopping basket

Contrary to the Examiner's assertion, neither Blinn nor Bernard suggests that interest in another product without having placed the primary product in a virtual shopping basket is the basis for detecting a loss of interest in the primary product. In Bernard there is no suggestion of doing anything in response to having items "on hold" other than the explicitly described prompt to the caller, much less determining a package of any kind to offer a customer. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for Claim 121.

### 3.04. Claim 122

Claim 122 contains the following limitation:

wherein detecting a loss of interest in the primary product comprises:

determining that the primary product has been in a virtual shopping basket associated with the customer for a predetermined amount of time without having been purchased

Contrary to the Examiner's assertion, neither Blinn nor Bernard suggests that a primary product being in a virtual shopping basket for a predetermined amount of time without having been purchased is the basis for detecting a loss of interest in the primary product. In Bernard there is no suggestion of doing anything in response to having items "on hold" other than the explicitly described prompt to the caller, much less determining a package of any kind to offer a customer. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for Claim 122.

**H. ADDITIONAL COMMENTS**

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

**I. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES**

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Deposit Account: 50-0271

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Please credit any overpayment to the same account.

**J. CONCLUSION**

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mdowns@walkerdigital.com](mailto:mdowns@walkerdigital.com).

Respectfully submitted,

October 31, 2007

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